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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/540,585	06/27/2005	Kazuo Mizubuchi	033622-012	5370

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EXAMINER

NUTTER, NATHAN M

ART UNIT	PAPER NUMBER
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1796

NOTIFICATION DATE	DELIVERY MODE
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12/28/2009

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

ADIPFDD@bipc.com

Office Action Summary	Application No. 10/540,585	Applicant(s) MIZUBUCHI ET AL.	
	Examiner Nathan M. Nutter	Art Unit 1796	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 September 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 7 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 7 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>10-09-09</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

In response to the amendment filed 28 September 2009, the following is placed in effect.

The status identifier for claim 7 should be "Previously Presented," and not "New."

The Substitute Specification filed 28 September 2009 has been entered. The objection to the disclosure under 37 CFR 1.52(a) and (b) is hereby expressly withdrawn.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claim 1 is rejected under 35 U.S.C. 102(b) as being clearly anticipated by Oku (US 5,276,080).

Note column 5 (line 45) to column 6 (line 20), column 7 (lines 55-63), column 9 (lines 55-64) and the paragraph bridging column 10 (line 58) to column 11 (line 17).

Claims 1 and 7 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Shimasaki et al (US 5,498,654).

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Note the Abstract, column 3 (lines 23-35) and column 4 (lines 40-49).

Claims 1 and 7 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Yamamoto et al (US 5,988,891).

Note the Abstract, column 4 (lines 33-52), column 5 (lines 29-44), column 5 (line 45) to column 7 (line 27).

Claim 1 is rejected under 35 U.S.C. 102(e) as being anticipated by Sato et al (US 6,675,770).

Note column 3 (lines 29-41), column 5 (lines 1-15 and 44-54), the paragraph bridging column 5 to column 6, the paragraph bridging column 11 to column 12, column 13 (lines 35-43) and column 14 (lines 29-44 and 50-56) and the Examples.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 1 is rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Yoshinaka et al (US 5,183,594).

The reference to Yoshinaka et al teaches the production of a resin composition that may comprise a tetrafluoroethylene polymer at column 12 (lines 38-53) with zinc

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oxide whiskers having a tetrapodal shape with particulate and fibrous filler materials including talc, glass fiber, copper, zinc oxide, graphite, etc.. Note column 13 (lines 35-43) and column 14 (lines 29-44). Note the paragraph bridging column 11 to column 12, column 14 (lines 50-56) and the Examples for the compositional limitations that overlap with those recited herein. Note the paragraph bridging column 8 to column 9. The reference shows the contemplated sizes for the zinc oxide whiskers, as recited herein, at the paragraph bridging column 11 to column 12, and teaches the benefits of size. This suggestion is sufficient to establish a size range for the particulate and other fibrous materials as added herein. As such, the instant claim is deemed to be at least obvious, if not anticipated, by the teachings of the reference to Yoshinaka et al.

Claim 1 is rejected under 35 U.S.C. 103(a) as obvious over Yoshinaka et al (US 5,310,598).

The reference teaches the production of the PTFE composition. Note column 2 (lines 4-10), the paragraph bridging column 2 to column 3, the paragraph bridging column 3 to column 4, column 6 (line 35) to column 7 (line 2) and the many Examples. Though the reference does not teach the compositional limitations of the constituents, as now claimed, a skilled artisan would know what parameters would be suitable with a view to the end-use of the composition.

Response to Arguments

Applicant's arguments filed 28 September 2009 have been fully considered but they are not persuasive.

All arguments of record are maintained herein.

The recitation of the process step “prepared by suspension polymerization” is given no patentable weight since it is not deemed to be a claim limitation. See SmithKline Beecham Corp. v. Apotex Corp., No. 04-1522 (Fed. Cir. February 24, 2006).

Further, applicants argue MPEP § 2113 allows applicants “an opportunity to provide evidence that the recited process has an substantive effect on the resulting polymer,” and has provided an excerpted Japanese document with a partial translation, not certified, “Fluororesin Handbook” edited by Takaomi Satokawa and printed by Nikkei Kogyo. Applicants contend the partial, not-certified, passage shows “that the polymer prepared by suspension polymerization provides molding grade polymer powder whereas emulsion polymerization provides fine polymer grade or a polymer dispersion.” Applicants state that the “powder is easily fibrillated by a weak shearing force and thus molded articles prepared therefrom are easily cracked.” This has not been established by the document. Neither have any comparative showings been made as to the reference composition of each reference cited. No direct comparisons have been presented. Further, the document to Japanese Standard JIS Z 2500, with partial uncertified English, fails to establish any literal difference or any language nuance concerning granular and spheroidal. The terms are deemed to be synonymous with each other.

With regard to the rejection of claim 1 under 35 U.S.C. 102(b) as being clearly anticipated by Oku (US 5,276,080), applicants argue “(t)he resins...described in the passage beginning at column 9, line 53...notably do not include a tetrafluoroethylene

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polymer.” Applicants then agree that “in the paragraph beginning at column 10, line 58, a solid lubricant such as polytetrafluoroethylene,” may be included in the composition. Applicants argue the Examples fail to show the PTFE resin. It is pointed out to applicants that the disclosure of the resin is tantamount to its use in an identical capacity, especially since there is overlap of the lubricant at 25 to 30 wt % at the paragraph bridging column 10 to column 11. The reference is not limited to specific examples or isolated passages, but as to the entirety of its teachings. See above regarding applicants' arguments concerning the limitation "prepared by suspension polymerization."

With regard to the rejection of claims 1 and 7 under 35 U.S.C. 102(b) as being clearly anticipated by Shimasaki et al (US 5,498,654), applicants contend, but have provided no evidence or comparative data, as to a difference of product regarding "spherical carbon particles," as opposed to powder. See the statement set out above. Further, applicants contend, but has not been shown to be such, the “spherical carbon particles as exemplified by Bellpearl C-2000 identified in the first paragraph of column 5....is the material used in the comparative experiment provided herewith and discussed above.” Nothing in the Comparative data of Table 1 indicates the trademarked constituent. See above regarding applicants' arguments concerning the limitation "prepared by suspension polymerization."

With regard to the rejection of claims 1 and 7 under 35 U.S.C. 102(b) as being clearly anticipated by Yamamoto et al (US 5,988,891), see above regarding applicants' arguments concerning the limitation "prepared by suspension polymerization." Further, while the amendment of 28 September did cancel "talc, glass fiber, and molybdenum disulfide," from claim 1, the reference teaches the use of graphite, as well.

With regard to the rejection of claim 1 under 35 U.S.C. 102(e) as being anticipated by Sato et al (US 6,675,770), see above regarding applicants' arguments concerning the limitation "prepared by suspension polymerization." Further, applicants contend, the reference at column 7 (lines 50 et seq.) teaches "the type of spherical carbon (Bellpearl C-2000) used in the comparative experiment provided herewith." Specifically the reference teaches Bellpearl line of products, as well as others. Nothing in the Comparative data of Table 1 indicates the trademarked constituent. Further, nothing has been shown to compare directly the product of the reference with that claimed herein.

With regard to the rejection of claim 1 under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Yoshinaka et al (US 5,183,594), see above regarding applicants' arguments concerning the limitation "prepared by suspension polymerization." Further, it is pointed out the reference teaches limited inclusion of constituents for the thermoplastic resin, and a skilled artisan would know why to select one over the other (an eye to end-product, availability, cost,

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etc.). While talc and glass powder are no longer recited in claim 1, copper powder and graphite, recognized by the reference, remain recited. A skilled artisan would have a high level of expectation of success following the teachings of the reference to achieve the instantly claimed product.

With regard to the rejection of claim 1 under 35 U.S.C. 103(a) as obvious over Yoshinaka et al (US 5,310,598), see above regarding applicants' arguments concerning the limitation "prepared by suspension polymerization." The absence of Examples in the reference is not relevant to the teachings included therein. The patentees did not have to recognize the "advantageous results illustrated by the record" to obviate the instant claims.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nathan M. Nutter whose telephone number is 571-272-1076. The examiner can normally be reached on 9:30 a.m.-6:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James J. Seidleck can be reached on 571-272-1078. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Nathan M. Nutter/
Primary Examiner, Art Unit 1796

nmn

19 December 2009

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